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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,230	04/19/1999	CHRISTOPHER EWING	3175.01A	6950

7590 07/11/2002

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EXAMINER
DIXON, THOMAS A

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/295,230	EWING, CHRISTOPHER	
	Examiner	Art Unit	
	Thomas A. Dixon	3629	

-- The MAILING DATE of this communication appears n the c ver sheet with the correspondence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. Claim 22 objected to under 37 CFR 1.75 as being a substantial duplicate of claim 21. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Public Use or Sale

2. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:.a brief explanation regarding Chris Ewing's association with BlindGift and/or ZipSend is required.

The references, BlindGift.com and ZipSend, give and appearance of issues regarding a public use or on sale bar. BlindGift.com, line 24, and ZipSend, line 30 indicate that a patent application pending, however, it is Shari's Berries president, Chris Ewing, who is the applicant in this case. Shari's Berries is said to be in a partner agreement with BlindGift.com to use the BlindGift system for sending gifts with only a recipient's email address. It appears that the BlindGift system is used by Shari's Berries and was, therefore, on sale by BlindGift before the invention thereof by Ewing.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Claim R j ctions - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2, 4, 10-12, 19, 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Van Name et al.

As per Claim 1.
Van Name et al discloses:
receiving a request over the internet from a first party for a gift to be sent to a second party, see page 1, lines 45-50;
obtaining over the Internet from said first party a pseudonym of said second party, see page 1, lines 45-50;
securing over the Internet a non-pseudonymous name and address associated with the second party's pseudonym, see page 1, lines 45-50; and
producing computer output enabling said gift to be sent to said second party while said non-pseudonymous name is not revealed to said first party, see page 1, lines 45-50.

As per Claim 2.
Van Name et al further discloses the step of issuing an order that said gift be send to said second party's non-pseudonymous name and address, see lines 49-50.

As per Claim 4.
Van Name et al further discloses contacting said second party and requesting revelation of said second party's non-pseudonymous name and address, see lines 49-50.

As per Claim 10.
Van Name et al further discloses electronically contacting a third party for sending of a gift, see lines 7-10.

As per Claim 11, 28.
Van Name et al further discloses giving the first party an opportunity to reveal true identity information about said first party's self, see lines 36-37 and line 48.

As per Claim 12, 29.
Van Name et al further discloses giving the second party an opportunity to reveal true identity information about said second party's self, see lines 49-50.

As per Claim 19.
Van Name et al discloses:
a web site, operably connected to said computers, enabling said first party to identify send said gift to said second party by a pseudonym of said second party without said web site revealing a non-pseudonymous name to said first party, see page 1, lines 45-50.

As per Claim 30.
Van Name et al further discloses gift is sent responsive to a message from the second party, see lines 49-50.

As per Claim 31.
Van Name et al further discloses gift is sent responsive to an acceptance communication from the second party, see lines 49-50.

As per Claim 32.
Van Name et al further discloses gift is sent only responsive to an acceptance communication from the second party, see lines 49-50.

As per Claim 33.
Van Name et al further discloses a web site, see line 7.

4. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Webcertificate.

As per Claim 19.
Webcertificate discloses:
a web site, operably connected to said computers, enabling said first party to identify send said gift to said second party by a pseudonym of said second party without said web site revealing a non-pseudonymous name to said first party, see page 1, lines 4-31.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Name et al in view of Baron et al (5,809,481).

As per Claim 3.

Van Name et al discloses the limitations of Claim 1.

Van Name et al discloses the collection of non-pseudonymous name and address information, see line 49, but does not specifically disclose looking up the second party's pseudonym in a database.

Baron et al ('481) teaches a database lookup for customer registration information, see column 7, lines 57 – column 8, line 32 for the benefit of management record keeping.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to perform a database lookup of the second party's information to ease the keying in of registration information and increase customer goodwill.

6. Claims 5, 6, 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Name et al in view of Baron et al (5,809,481).

As per Claim 5.

Van Name et al discloses the limitations of Claim 1.

Van Name et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44.

Van Name et al does not disclose storing said second parties preference to opt out.

Baron et al ('481) teaches storing preferences in a database in association with said second party's pseudonym or name and address, see column 7, lines 22-47 for the benefit of collecting registration information from a user.

Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to collect information, such as the preference to opt out, at the time of registration for the benefit of collecting privacy information from a customer.

As per Claim 6.

Van Name et al in view of Baron et al ('481) discloses all the limitations of claim 5.

Van Name et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44.

Baron et al ('481) teaches checking said second party's stored preferences, see column 9, lines 8-18 and column 7, line 22 – column 8, line 32 for the benefit of management record keeping.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to perform a database lookup of the second party's information to ease the keying in of registration information and increase customer goodwill.

As per Claim 7.

Van Name et al in view of Baron et al ('481) discloses all the limitations of claim 5.

Van Name et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44 and sending a gift to a mailing address, see lines 49-50.

As per Claim 8.

Van Name et al in view of Baron et al ('481) discloses all the limitations of claim 5.

Van Name et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44.

Van Name et al does not disclose preference to "opt out" of gift receipt.

Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to collect information, such as the preference to opt out, at the time of registration for the benefit of collecting privacy information from a customer.

7. Claims 9, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Name et al in view of Webcertificate.

As per Claim 9.

Van Name et al discloses all the limitations of claim 1.

Van Name et al does not disclose a confirmation of the of gift.

Webcertificates, page 1, lines19-21 teach confirming the gift as a common business practice.

Official Notice is taken that it is a matter of law that consumers cannot be charged for products or services not received.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to notify the buyer that the gift has not been accepted, for the benefit of compliance with standard business practice and legal requirement.

As per Claim 15.

Van Name et al discloses all the limitations of claim 13.

Van Name et al further discloses electronically charging a fee to a charge card, see line 44.

Webcertificates, page 1, lines19-21 teach confirming the gift as a common business practice.

Official Notice is taken that it is a matter of law that consumers cannot be charged for products or services not received.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to notify the buyer that the gift has not been accepted, for the benefit of compliance with standard business practice and legal requirement.

8. Claims 13-14, 16-18, 21-27 is rejected under 35 U.S.C. 102(e) as anticipated by

or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Name et al.

As per Claim 13, 20.

Van Name et al further discloses electronically charging a fee to said first party, see lines 12-13 and 44.

Official Notice is taken that it is well know to charge a fee for a transaction, for example, Banks have long charged electronic transaction fees associated with Automated Teller Machines use for the benefit of providing convenience to the customer in receiving money at convenient times, further, credit card companies charge a fee, sometimes between 2-8% of each transaction for the convenience of shopping with the card.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a transaction fee to the first party as a service or handling fee associated with the gift.

As per Claim 14.

Van Name et al discloses all the limitations of claim 13.

Van Name et al further discloses electronically charging a fee to a charge card, see line 44.

As per Claim 16.

Van Name et al further discloses electronically charging a fee to said first party, see lines 12-13 and 44.

Official Notice is taken that it is well know to charge a fee for a transaction, for example, Banks have long charged electronic transaction fees associated with Automated Teller Machines use for the benefit of providing convenience to the customer in receiving money at convenient times, further, credit card companies charge a fee, sometimes between 2-8% of each transaction for the convenience of shopping with the card.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a transaction fee to the first party as a service or handling fee associated with the gift.

As per Claim 17.

Van Name et al further discloses electronically charging second fee related to the value of the gift, see lines 12-13 and 44.

Official Notice is taken that it is well know to charge a fee for a transaction, for example, Banks have long charged electronic transaction fees associated with Automated Teller Machines use for the benefit of providing convenience to the customer in receiving money at convenient times, further, credit card companies charge a fee, sometimes between 2-8% of each transaction for the convenience of shopping with the card.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a transaction fee to the first party as a service or handling fee associated with the gift.

As per Claim 18.

Van Name et al further discloses electronically charging a fee to said second party, see lines 13-14 and 49-50.

Official Notice is taken that it is well know to charge a fee to the receiving party of a gift, for example, cereal boxes have long had ads for a "free" gift/toy to be sent to the consumer of the cereal in exchange for box tops or a handling fee.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to charge a fee to the second party as a service or handling fee associated with the "gift".

As per Claim 21, 22.

Van Name et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44.

Van Name et al does not disclose storing said second parties preference to opt out.

Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to collect information, such as the preference to opt out, at the time of registration for the benefit of collecting privacy information from a customer.

As per Claim 23.

Van Name et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44.

Van Name et al does not disclose storing said second parties preference to opt out.

Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to collect information, such as the preference to opt out if

the sender is not identified by a true name, at the time of registration for the benefit of collecting privacy information from a customer.

As per Claim 24.

Van Name et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44.

Van Name et al does not disclose storing said second parties preference to opt out.

Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to collect information, such as the preference to opt out of gift receipt from a particular person, at the time of registration for the benefit of collecting privacy information from a customer.

As per Claim 25.

Van Name et al further discloses registered shoppers and known systems which perform database lookups, see lines 36-44.

Van Name et al does not disclose storing said second parties preference to opt out.

Official Notice is taken that it is a matter of law that consumers be given the opportunity to "opt out" of marketing programs for the benefit of personal privacy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to collect information, such as the preference to opt out of gift based on the particular gift, at the time of registration for the benefit of collecting preference information from a customer.

As per Claim 26.

Van Name et al further discloses the use of email addresses for sending gifts, see lines 45-50.

Van Name et al does not disclose enabling said second parties to respond to said first party after receipt of said gift.

Official Notice is taken that replying to an email is well known in the computer arts. Further it is well known in society to send thank you notes to the sender upon receipt of a gift as a matter of courtesy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention to reply to an email to send a thank you note to the sender upon receipt of a gift as a matter of courtesy.

As per Claim 27.

Van Name et al further discloses the use of email addresses for sending gifts, see lines 45-50.

Van Name et al does not disclose enabling said second parties to respond to said first party after refusal of said gift.

Official Notice is taken that replying to an email is well known in the computer arts. Further it is well known in society to say "no, thank you" upon refusal of a gift, for example "no, thank you, I'm allergic to nuts" as a matter of courtesy.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention to reply to an email to send a note saying no thank you to the sender upon refusal of a gift as a matter of courtesy.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Thomas A. Dixon
Examiner
Art Unit 3629

July 9, 2002